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EXAMINER

STOLE, E

ART UNIT

1652

PAPER NUMBER

13

DATE MAILED: 02/02/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action SummaryApplication No.
08/851,089

Applicant(s)

Darzins et al.

Examiner

Einar Stole

Group Art Unit

1652 Responsive to communication(s) filed on Nov 3, 1998 This action is FINAL. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims Claim(s) 1-75 is/are pending in the application.

Of the above, claim(s) 1 and 54-75 is/are withdrawn from consideration.

 Claim(s) 9-45 is/are allowed. Claim(s) 2, 4, 6, 8, and 46-53 is/are rejected. Claim(s) 3, 5, and 7 is/are objected to. Claims 1-75 are subject to restriction or election requirement.**Application Papers** See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948. The drawing(s) filed on _____ is/are objected to by the Examiner. The proposed drawing correction, filed on _____ is approved disapproved. The specification is objected to by the Examiner. The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119** Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

 Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)** Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449, Paper No(s). 10 Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review, PTO-948 Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Claims 1-75 are still pending.

Election/Restriction

2. Applicant's election **without traverse** of Group II, claims 2-53, in Paper No. 12, is acknowledged.

3. Claims 1 and 54-75 and withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without traverse** in Paper No. 12.

4. This application contains claims drawn to an invention nonelected **without traverse** in Paper No. 12. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. The requirement is still deemed to be proper and is therefore made FINAL.

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Claim Objections

7. Claims 3, 5, and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

8. In view of Applicants' statement regarding deposit of biological material in the remarks, filed on November 12, 1998 in Paper No. 12, the rejection of claim 27, 28, 32, 33 and 38, under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, is withdrawn.

9. Claims 2, 4, 6, 8, and 46-53, stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is explained in the previous Office action.

Although Applicants' amendments overcome this rejection with respect to "mutants" and "fragments", "homologue" remains in the claims. Applicants' arguments filed on November 12, 1998 in Paper No. 12, have been fully considered but they are not persuasive. Specifically, the instant specification does not teach the skilled artisan how to determine whether a protein or nucleic acid shares a defined degree of identity with a reference protein or nucleic acid, respectively. The term

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“homologue” is defined on page 24, lines 24-33. Although the instant specification discusses numerous algorithms used in the art to determine identity between sequences, the instant specification neither specifies which algorithm was used to determine the degree of identity of the claimed molecules nor does the specification indicate which parameters were used. For example, the necessary parameters required to calculate the claimed sequence identity, using a disclosed, given algorithm, include gap penalties and mismatch penalties. Since a variety of methods or algorithms and parameters for calculating sequence identity, similarity or homology are known in the art, an explicit teaching of how these calculations are made is required to interpret the claim.

10. In view of Applicants’ amendments and arguments, filed on November 12, 1998 in Paper No. 12, the rejection of claim 3, 5, 7, and 24-39, under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is withdrawn.

Claim Rejections - 35 USC § 102

11. In view of Applicants’ amendments and arguments, filed on November 12, 1998 in Paper No. 12, the rejection of claims 28, 34, and 39, under 35 U.S.C. 102(b), as being anticipated by the Sigma Catalog (Y), is withdrawn.

Conclusion

12. Claims 3, 5, 7, and 9-45 are allowable over the prior art of record.

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13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. The Group and Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1652.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Einar Stole, Ph.D., whose telephone number is (703) -305-4507. The examiner can normally be reached Tuesday through Friday 6:30 a.m. to 5:00 p.m.

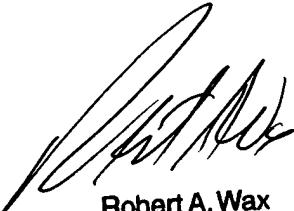
If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Robert A. Wax, can be reached on (703)-308-4216. The fax phone number for Technology Center 1600 is (703)-305-7401.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703)-308-0196.

Einar Stole, Ph.D.

January 29, 1999



Robert A. Wax
Supervisory Patent Examiner
Technology Center 1600